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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,846	07/01/2003	Mark Schmidt	108-194USAND0	2761
7590	09/23/2005		EXAMINER	
Thomas J. Perkowski, Esq., P.C. Soundview Plaza 1266 East Main Street Stamford, CT 06902			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)
	10/611,846	SCHMIDT ET AL.
Examiner	Art Unit	
Ahshik Kim	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 7/1/03 (preliminary amendment).
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 93-96 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 93-96 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 01 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/4/03, 5/28/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the preliminary amendment filed on July 1, 2003. In the
5 claims 1-92 were canceled, and claims 93-96 were newly added. Currently, claims 93-96 remain
in the examination.

Specification

2. The lengthy specification and a large number of drawings have not been checked to the
10 extent necessary to determine the presence of all possible minor errors. Applicant's cooperation
is requested in correcting any errors of which applicant may become aware in the specification.

Obviousness-Type Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in
15 public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise
extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple
assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759
F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163
20 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome
an actual or provisional rejection based on a nonstatutory double patenting ground provided the
conflicting application or patent is shown to be commonly owned with this application. See 37
CFR 1.130(b).

25 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.
A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 93-96 are provisionally rejected under the judicially created doctrine of

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obviousness-type double patenting as being unpatentable over claims 1, 4, 6, 17, and 25 of co-pending Application No. 10/342,433(hereinafter ‘433 application).

Although the conflicting claims are not identical, it is the Examiner’s view that they are not patentably distinct from each other. In claims 93-96 of the instant application, the Applicant 5 claims an automatically-activated laser scanning 2D bar code symbol reading system comprising a hand-supportable housing which includes an automatically-activated laser scanning 2-D bar code symbol reading mechanism disposed therein; the reading mechanism further includes a bar code symbol data detector, an audible data capture buffering indicator, a data transmission circuit, a device controller controlling 2-D barcode symbol reading mechanism and transmission 10 circuit.

Claim 1 of ‘433 application recites An automatically-activated bar code symbol reading system comprising: (1) a hand-supportable housing supportable in or on the hand of a user, and having a light transmission aperture through which visible light can exit and enter said hand-supportable housing; (2) automatic scan data producing means in said hand-supportable housing 15 for producing scan data from a bar code symbol on an object located within at least a portion of a laser scanning field definable relative to said hand-supportable housing, said scan data producing means including (i) a laser beam producing means disposed in said hand-supportable housing for producing and projecting a laser beam through said light transmission aperture, (ii) canning means for repeatedly scanning said laser beam across said laser scanning field and across said 20 bar code symbol on said object, and (iii) laser light detecting means for detecting the intensity of laser light reflected off said bar code symbol and passed through said light transmission aperture and for automatically producing scan data indicative of said detected light intensity; (3) bar code

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symbol detection means in said hand-supportable housing for processing produced scan data so as to detect the presence of said bar code symbol on said object and to automatically generate a first control activation signal (A2) in response to the detection of said bar code symbol in said laser scanning field; (4) decode processing means in said hand-supportable housing for processing produced scan data so as to decode said bar code symbol on said object and for automatically producing symbol character data representative of said decoded bar code symbol, and automatically generating a second control activation signal (A3) indicative of the production of said symbol character data; (5) manually-actuable data transmission switch integrated with said hand-supportable housing, for producing a third control activation signal (A4) in response to the manual-actuation of said manually-actuable data transmission switch; (6) data transmission means in said hand-supportable housing, for transmitting said symbol character data to a host device operably connected to said automatic bar code symbol reading system only in response to the occurrence of at least said second and third control activation signals; and (7) system control circuitry for automatically controlling the operation of said automatic bar code symbol reading system in response to the generation of said first, second and third control activation signals.”

It is the Examiner’s view that both claim 1 of the instant application and 433 application recite the same barcode reading apparatus. Only difference is that claim 1 of ‘433 does not mention 2-D barcode which is recited in dependent claim 25. Object detector utilizing Infrared (IR) mentioned in claim 95 is recited in claim 17 of ‘433 application.

Thus, with respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1, 4, 6, 17, and 25 of '433 application as a general teaching to design a similar lighting and image capturing apparatus disclosed in the

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instant application. To the extent that the instant claim is broader and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

5 This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
15 thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an
20 international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 93-96 are rejected under 35 U.S.C. 102(e) as being anticipated by Bridgelall et al. (US 6,415,982, hereinafter Bridgelall).

Bridgelall discloses a two-dimensional barcode reader (col. 1, lines 35+; col. 2, lines 37+) which functions in automatic manner (col. 4, lines 35+) comprising a decoder (col. 1, lines 57+), a bar code symbol data detector (col. 3, lines 34+) and audible sign (col. 3, lines 16+) indicating successful read of the data, and a data transmission component (see abstract) transceiving the 5 data with a host machine. The reader can incorporate radio frequency tag (col. 4, lines 22+) or infrared in object detection or wireless communication (col. 10, lines 37+).

Conclusion

Any inquiry concerning this communication or earlier communications from the 10 examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's 15 supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be 20 addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly 25 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent 30 Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim

Primary Examiner

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September 16, 2005

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